

REMARKS

Favorable reconsideration of the above-identified application is requested in view of the following remarks.

The Examiner is thanked again for indicating that Claim 6 is allowable. Thus, Claims 1-5 and 7-15 are at issue in this application, with Claims 1, 14 and 15 being independent.

Claims 1 and 14 are amended to replace the word "and" with --or-- to remedy a minor grammatical issue and Claim 12 is amended to include a period. It is not believed that these amendments affect the scope of the claims and should therefore be entered after final rejection.

The Official Action rejects Claims 1, 2, 7-12, 14 and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No 5,129,639, hereinafter *DeHority*.

DeHority discloses a printer system which compares print job requirements to the printer capability. When a mismatch between the print job requirement and the printer capability occurs, the system determines the best alternate match between the size, color, weight and type of paper by determining a mismatch magnitude. In column 3, lines 40-45, *DeHority* describes two modes of operation. The first mode automatically selects an alternative match when a mismatch occurs. The second mode is similar to the first, but adds the step of checking if the determined alternate match is acceptable to the user. The modes have nothing to do with the environment in which the printer operates.

Some of the presently claimed subject matter is generally directed toward a printing system that includes a printer that operates in either a first operating environment or a second operating environment that is different from the first

operating environment. Features relating to that subject matter are presently included in Claims 1, 14 and 15, together with the other claimed features.

One of the issues addressed in the previous Response and Official Actions involves the Examiner's interpretation of the claim language directed toward a first operating environment and a second operating environment that is different than the first. In the Official Action, it is posed that the two modes described in *DeHority* constitute two different operating environments as defined by the claims. However, it is not reasonable to interpret *DeHority*'s different modes as disclosing the claimed operating environments, and such cannot form the basis of the rejections for at least the following reasons.

In the last Office Action, the Examiner focuses on the term "surround". However, the relevant term is "environment". Thus, even if a program confines a printer, it does not literally "surround" the printer, and is clearly not the environment. As for setting the time issue raised by the Examiner, the actual time is the environment, the setting of a time in the printer merely enables the printer to respond in accordance with the time, i.e., the environment.

For the reasons set forth below, applicants continue to assert that there are significant differences between the claims and the prior art.

According to the American Heritage Dictionary, an "environment" is the circumstances or conditions that surround one; surroundings and the totality of circumstances surrounding an organism or a group of organisms. Further, "surround" means to extend on all sides of simultaneously; encircle. In contrast, the different modes referred to by *DeHority* are within the printer and do not surround or encircle the printer. That is, the modes are internal and change the way the system

operates, irrespective of the external operating environment which surrounds the system. Thus, by definition, *DeHority*'s modes do not disclose a first and second operating environment as defined by the claims.

Further, the specification of the present application clearly supports the dictionary definitions of "environment". On page 1, line 25 through page 2, line 3 of the present application describes an environment where the "paper or toner cannot be immediately replenished because the printer is used through a network and there is no one located near the printer, such as at a print shop at night where the manager is not present..." It is clear that a print shop is an example of an operating environment and surrounds the printer. Further, on page 26, lines 7-10 of the present application, it is stated that "[b]y checking the data that it has received, the printer may determine that it is in an environment in which paper or toner may not be immediately replenished."

Thus, in view of the common dictionary definition and the specification, there is no reasonable interpretation of the claim language relating to the first and second "operating environment" that would indicate that such covers the two modes described by *DeHority*. The Examiner is respectfully requested to acknowledge this fact by withdrawing the rejections.

Claims 2 and 7-12 are allowable at least by virtue of their dependence from allowable independent claims, and because they define features that further define over the cited disclosure.

Claims 3, 4, and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over *DeHority* as applied to Claim 1, and further in view of U.S. Patent No. 6,160,269, hereinafter *Tang*. However, *Tang* does not overcome the deficiency

of the rejection of Claim 1 as discussed above. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections of Claims 3, 4 and 5 based on *DeHority* and *Tang*.

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *DeHority* as applied to Claim 1 above, and further in view of U.S. Patent No. 5,467,434, hereinafter *Hower*. However, like *Tang*, *Hower* does not overcome the deficiency of the rejection of Claim 1 based on *DeHority*. Accordingly, Claim 13 is also patentable over the applied prior art at least for the reasons set forth above with respect to Claim 1.

In view of the foregoing remarks and amendment, the Examiner is respectfully urged to reconsider and withdraw the outstanding rejections.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: Monday, June 20, 2005

By: William C. Rowland
William C. Rowland
Registration No. 30,888

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620